

03-10-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #30

TTAB
**UNITED STATES PATENT AND TRADEMARK
OFFICE**

Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: February 19, 2003

Registration No. 1563975

Cancellation No. 92041613

Terence Conran Limited and Sir Terence Orby
Conran

v.

HABITAT HOLDING B.V.

DAVID EHRLICH
WEISS DAWID FROSS ZELNICK & LEHRMAN, P.C.
633 THIRD AVENUE
NEW YORK, NY 10017

Eric McWilliams, Legal Assistant

A petition, copy of which is attached, has been filed to cancel the above-identified registration.

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that became effective October 9, 1998. See Notice of Final Rulemaking published in the *Official Gazette* on September 29, 1998 at 1214 TMOG 145. Slight corrections to the rules, resulting in a correction notice, were published in the *Official Gazette* on October 20, 1998 at 1215 TMOG 64. A copy of the recent amendments to the Trademark Rules, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

In the registration here involved, respondent has designated David Ehrlich of Weiss Dawid Fross Zelnick & Lehrman as its U. S. representative on whom may be served notices affecting this mark.

If the respondent desires to be represented by counsel in this proceeding, a power of attorney to that effect may be filed, or respondent's chosen counsel may simply make an appearance pursuant to Patent and Trademark Rule 2.17. Respondent's copy of communications from the Board will be sent to respondent's domestic representative until counsel is appointed or makes an appearance in behalf of respondent. See Trademark Rule 2.119(d).

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Patent and Trademark Rule 1.7 for expiration date falling on Saturday, Sunday, or a holiday.)

Discovery and testimony dates are set as indicated below. In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the

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TRADEMARK TRIAL AND
APPEAL BOARD

adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Discovery period to open: **March 11, 2003**

Discovery period to close: **September 07, 2003**

Testimony period for party in position of plaintiff to close: **December 06, 2003**

Testimony period for party in position of defendant to close: **February 04, 2004**
(opening thirty days prior thereto)

Rebuttal testimony period to close: **March 20, 2004**

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: This proceeding is subject to the pilot project on telephone disposition of interlocutory matters. See the Official Gazette notice titled "*Pilot Project on Telephone Disposition of Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board*," 1213 TMOG 151 (August 18, 1998). A hard copy of the notice announcing the pilot project is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 (Telephone (202) 512-1800). The notice is also available at <http://www.uspto.gov>. Any interlocutory matter proposed for discussion or resolution during a Board approved phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks, or during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

TTAB



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Registration No. 1,563,975
Mark: CONRAN'S HABITAT
Registration Date: October 31, 1989

TERENCE CONRAN LIMITED,
AND
SIR TERENCE ORBY CONRAN,

Petitioners,

vs.

HABITAT HOLDING B.V.
CORPORATION

Respondent.

[Redacted]
01-30-2003
U.S. Patent & TMO/TM Mail Recpt Dt. #30
[Redacted]
03-10-2003
U.S. Patent & TMO/TM Mail Recpt Dt. #30
CANCELLATION NO. [Redacted]

PETITION FOR CANCELLATION

BOX TTAB - FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Petitioners, Terence Conran Limited, a British corporation having a principal place of business at 22 Shad Thames, London SE1 2YU, United Kingdom (hereinafter known as "Conran Limited") and Sir Terence Orby Conran, an individual and citizen of the United Kingdom, also doing business at 22 Shad Thames, London SE1 2YU, United Kingdom (hereinafter "Sir Terence") believe that they are now and will continue to be damaged by U.S. Registration No. 1,563,975 and hereby petition to cancel same.

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[Signature]

In the Matter of Trademark Registration No. 1,563,975
Mark: CONRAN'S HABITAT
Registration Date: October 31, 1989

STATEMENT OF FACTS FOR PETITION

1. U.S. Registration No. 1,563,975, (hereinafter referred to as the "Subject Registration") issued on the Principal Register for the mark CONRAN'S HABITAT, and this registration is currently active on the Register.

2. The identification of services in the Subject Registration reads: "retail department store services" in International Class 42.

3. The Subject Registration was issued on October 31, 1989, to Conran Stores, Inc. ("CSI") with an address of 10 Astor Place, New York, New York 10003.

4. The Subject Registration was assigned to Aurora XII BV, a corporation of the Netherlands, which assignment was recorded in the U.S. Patent and Trademark Office Reel and Frame 0917/0653 on December 22, 1992. The Subject Registration was then assigned to Habitat Holding B.V. (hereinafter "Respondent"), a corporation of the Netherlands, located at 3012 CL Rotterdam Schouwburgplein 30-34 Amsterdam, Netherlands. This assignment was recorded in the U.S. Patent and Trademark Office Reel and Frame 1101/0237 on February 1, 1994.

5. Petitioners are the rightful owners of all right, title, and interest in and to various marks and names featuring the element "CONRAN" for retail department store services, furniture, light fixtures, paper goods, domestic utensils and containers, textile articles, and rugs as well as other goods related to home furnishings, including the marks

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TERENCE CONRAN and THE TERENCE CONRAN SHOP, which marks are often naturally shortened to CONRAN or CONRAN'S. At all times pertinent hereto, Petitioners have also been the rightful owners of all right, title, and interest in and to the marks featuring "CONRAN" as a trade name for a business that sells the foregoing goods and renders the foregoing services. As used herein, "Petitioners' goods," "Petitioners' products" and "Petitioners' business," as well as expressions to a similar effect mean the goods, the services and the business of Petitioners.

6. The marks featuring the element "CONRAN" were first used in commerce by Petitioners more than thirty eight years ago, in 1964, when Petitioners' first store opened in London, England. Petitioners' marks featuring the name CONRAN were first used in commerce in the United States more than twenty three years ago, in 1977, when Petitioners opened stores in the United States. Such marks of Petitioners are also used at present in connection with the advertising, promotion, sale and offering of Petitioners' goods and services in interstate commerce.

7. In 1989, Petitioners authorized CSI to use and register the marks CONRAN'S and CONRAN'S HABITAT in connection with retail store services in the United States. However, the last store owned and operated by CSI closed on or about March 31, 1994; and CSI abandoned its rights in such marks by discontinuing use of the marks in the United States without an intent to resume use. These CONRAN marks have

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not been used by CSI or Respondent or anyone in privity with CSI or Respondent since March 31, 1994.

8. The Petitioners' marks and names featuring the element CONRAN are of significant value to Petitioners as identifications of source in connection with the promotion, sale and offering of the products and services of Petitioners; and such marks and names distinguish Petitioners' products and services from those of others. In this regard, Petitioners' marks and names featuring the element CONRAN have come to signify and represent the persona of Sir Terence himself.

9. On May 11, 1999, Petitioner Conran Limited filed with the United States Patent and Trademark Office applications for registration of the marks THE TERENCE CONRAN SHOP and TERENCE CONRAN under the provision of Section 1(b) of the Trademark Act, with respect to goods and services such as "retail department stores services" and "light fixtures" "paper goods" "furniture" "small domestic utensils and containers" "textile articles" "materials for covering existing floors" and other goods related to home furnishings in International Classes 11, 16, 20, 21, 24, and 27.

10. In December 1999, Conran Limited opened a store under the name and service mark of THE TERENCE CONRAN SHOP in New York City; and this store continues to do business today under such name and service mark.

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11. By Office Actions issued in connection with Conran Limited's applications to register THE TERENCE CONRAN SHOP and TERENCE CONRAN, the U.S. Patent and Trademark Office has refused registration to Petitioners with respect to such applications, stating that the refusal to register is based on Section 2(d) of the Trademark Act, with a citation to Reg. No. 1,563,975, the Subject Registration herein opposed.

COUNT I

12. Petitioners hereby incorporate by reference the allegations of paragraphs 1-11 above.

13. To the best of Petitioners' knowledge and belief, Respondent has not used the CONRAN'S HABITAT mark of the Subject Registration in the United States at any time and has not at any time preceding discontinuance of use by Respondent's predecessor had an intention to resume use of such mark. Nonuse of the mark of the Subject Registration for more than three consecutive years constitutes *prima facie* evidence of abandonment under Section 45 of the Lanham Act, 15 U.S.C. § 1127; and the registration should be cancelled on the ground of abandonment.

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14. If the said Reg. No. 1,563,975 is permitted to remain on the federal register, Conran Limited will be denied registration of its marks THE TERENCE CONRAN SHOP and TERENCE CONRAN with respect to the aforesaid goods and services, as set forth in its application, and Petitioners would therefore suffer great injury.

COUNT II

15. Petitioners hereby incorporate by reference the allegations of paragraphs 1-15 above.

16. Respondent's registration falsely suggests a close connection between Petitioners and Respondent and falsely suggests that Respondent's products and services identified by the Subject Registration are somehow manufactured by, sponsored by, endorsed by, or approved by Petitioners.

17. If the Subject Registration is permitted to remain of record, Respondent's registration would continue to falsely suggest a close connection between Petitioners and Respondent, and Petitioners would thus suffer great injury.

WHEREFORE, Petitioners, Conran Limited and Sir Terence Orby Conran pray that Registration No. 1,563,975 be cancelled on the grounds enumerated above.

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A check in the amount of \$600.00 is attached to cover the statutory filing fee. The Commissioner is hereby authorized to charge any additional fees that may be required, or credit any overpayment, to Deposit Account No. 19-0741.

Please direct all correspondence to Peter G. Mack, Foley & Lardner, 3000 K Street, Suite 500, Washington, District of Columbia 20007.

As required under 37 C.F.R. §2.112(a), this Petition to Cancel is being submitted in duplicate.

Respectfully submitted,

January 30, 2003
Date



Peter G. Mack
Counsel for Petitioners

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3000 K Street, N.W.
Washington, D.C. 20007-5109
Tel. No. (202) 672-5300
Fax No. (202) 672-5399

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WASHINGTON, DC 20231

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